

REMARKS

The above amendments and following remarks are submitted in response to the First Office Action of the Examiner mailed October 21, 2004. Having addressed all objections and grounds of rejection, claims 1-20, being all the pending claims, are now deemed in condition for allowance. Entry of these amendments and reconsideration to that end is respectfully requested.

Though the Examiner has not objected to the title, Applicants have amended the title to more appropriately describe the disclosure and pending claims. The Examiner has apparently objected to the specification, although no specific informalities are alleged. However, it is assumed that the objection arises from serial number and filing date information missing from page 1 of the specification. In response thereto, this information has been supplied.

The Examiner has rejected claims 9-11 under 35 U.S.C. 112, second paragraph, alleging various informalities. In response thereto, claims 9-11 have been amended above.

The Examiner has rejected claims 1-14 and 16-20 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,754,772, issued to Leaf (hereinafter referred to as "Leaf"). This ground of rejection is respectfully traversed for the reasons provided below.

To make an anticipation rejection in accordance with MPEP 2131, the Examiner must show that a reference contains every claim element either "expressly" or "inherently". MPEP 2131 states in part:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail

as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.... (emphasis added)

In other words, to make an anticipation rejection, the Examiner must find each claim element to be expressly disclosed "arranged as required by the claim" or inherently disclosed "arranged as required by the claim".

Claim 1, for example, requires "a first gateway.....which converts said service request.....without the use of a view buffer". In making his rejection, the Examiner cites Leaf, column 1, lines 25-27, and 57-67. Quite apart from the failure of these citations to mention "service request", there is no enabling discussion of how any CGI programs operate. Most importantly, there is certainly no showing that such CGI programs can perform conversion "without the use of a view buffer". In fact, the only CGI programs actually described by Leaf all require the use of a view buffer (see, for example, Figs. 3-8 and 12, and the descriptions thereof). As a result, Leaf does not "expressly" teach the claimed conversion "without the use of a view buffer" as required by MPEP 2131.

On the other hand, were the Examiner to allege that the cited portions of Leaf teach the claim limitations based upon inherency, he must comport with MPEP 2112, which provides in part:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by

persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

Clearly, the Examiner could not show that Leaf, column 1, lines 25-27 and 57-67, necessarily must perform the alleged conversion "without the use of a view buffer" as required by MPEP 2112, because the only clear teaching of Leaf is that a view buffer is necessary.

Because Leaf does not expressly or inherently meet all of the limitations of claim 1, Leaf cannot anticipate claim 1 as alleged by the Examiner. Therefore, the rejection of claim 1, and all claims depending therefrom, is respectfully traversed.

Claim 2 depends from claim 1 and is further limited by "a second gateway.....wherein said second gateway converts....through the use of a view buffer". In other words, claim 2 requires a first gateway not using a view buffer and a second gateway which does use a view buffer. In making his rejection, the Examiner confusingly suggests "instance of transaction gateway client". Whereas the Examiner is correct that Leaf teaches the use of more than one instance of the transaction gateway client, each instance performs conversion using a "view buffer". Thus, Leaf does not have a system which anticipates the invention of claim 2 in accordance with the requirements of MPEP 2131. The rejection of claim 2, and claims depending therefrom, is respectfully traversed.

Claim 3 depends from claim 2 and further limits the claimed network element. Because Leaf does not have all of the elements of claim 2, it cannot anticipate the unique combination claimed in claim 3. The rejection of claim 3 is respectfully traversed.

Claim 4 depends from claim 3 and further limits the claimed server and environment. Because Leaf does not have all of the elements of claim 3, it cannot anticipate the unique combination

claimed in claim 4. The rejection of claim 4 is respectfully traversed.

Claim 5 depends from claim 4 and further limits the claimed user terminal element. Because Leaf does not have all of the elements of claim 4, it cannot anticipate the unique combination claimed in claim 5. The rejection of claim 5 is respectfully traversed.

In rejecting claim 6, the Examiner again clearly erroneously finds that Leaf, column 1, lines 25-27, and lines 57-67, teaches "a first gateway....which converts.....without the use of a view buffer". This finding is clearly erroneous and contrary to controlling law as explained above. Again, the Examiner clearly erroneously equates a "web browser" with the claimed user terminal and a "database engine" with the claimed enterprise server. The rejection of claim 6 is respectfully traversed for failure of the Examiner to meet the requirements of MPEP 2131. The rejection of claim 6, and all claims depending therefrom is respectfully traversed.

Claim 7 depends from claim 6 and is further limited by "a second gateway.....which convertswith the use of a view buffer". As explained above, this means that claim 7 requires at least one gateway not using a view buffer and at least one gateway using a view buffer. Though Leaf teaches a plurality of instances, each instance requires the use of a view buffer. The rejection of claim 7 is respectfully traversed.

Claim 8 depends from claim 7 and further limits the claimed network element. Because Leaf does not have all of the elements of claim 7, it cannot anticipate the unique combination claimed in claim 8. The rejection of claim 8 is respectfully traversed.

Claim 9 depends from claim 8 and further limits the claimed server and environment. Because Leaf does not have all of the elements of claim 8, it cannot anticipate the unique combination

claimed in claim 9. The rejection of claim 9 is respectfully traversed.

Claim 10 depends from claim 9 and further limits the claimed user terminal element. Because Leaf does not have all of the elements of claim 9, it cannot anticipate the unique combination claimed in claim 10. The rejection of claim 10 is respectfully traversed.

Claim 11 is an independent method claim having three basic steps. Leaf does teach either of the first two steps in accordance with the citation of the Examiner (i.e., column 1, lines 25-27, and lines 57-67), because there is no service request. Perhaps of more importance, Leaf does not expressly or inherently teach the "converting.....without the use of a view buffer" step in accordance with the requirements of MPEP 2131. Therefore, the rejection of claim 11, and all claims depending therefrom, is respectfully traversed.

Claim 12 depends from claim 11 and is further limited by a transferring step. The citation of Leaf, column 1, lines 25-27, lines 57-67, and lines 63-65, do not teach this step, because they do not even mention the claimed "legacy data base management system". The rejection of claim 12, and claims depending therefrom, is respectfully traversed.

Claim 13 depends from claim 12 and further limits the claimed network element. Because Leaf does not have all of the elements of claim 12, it cannot anticipate the unique combination claimed in claim 13. The rejection of claim 13 is respectfully traversed.

Claim 14 depends from claim 13 and further limits the claimed first format. Because Leaf does not have all of the elements of claim 13, it cannot anticipate the unique combination claimed in claim 14. The rejection of claim 14 is respectfully traversed.

Claim 16 is an independent apparatus claim having "means-plus-function" limitations. Therefore, the claim is to be examined in accordance with the requirements of MPEP 2181, et seq. Again, the Examiner has made clearly erroneous findings with regard to Leaf, column 1, lines 25-27, and lines 57-67. Again, this citation of Leaf does not teach a "service request" and therefore cannot meet any of the four structural elements of claim 16. And again, Leaf does not expressly or inherently teach "means....for converting....without using a view buffer". The rejection of claim 16, and all claims depending therefrom, is respectfully traversed for failure of Leaf to meet the requirements of MPEP 2131.

Claim 17 depends from claim 16 and is further limited by "means....for transferring....via one of a plurality of connectors". Leaf has no such "plurality of connectors". The rejection of claim 17, and claims depending therefrom, is respectfully traversed for failure of Leaf to meet the requirements of MPEP 2131.

Claim 18 depends from claim 17 and further limits the claimed first format. Because Leaf does not have all of the elements of claim 17, it cannot anticipate the unique combination claimed in claim 18. The rejection of claim 18 is respectfully traversed.

Claim 19 depends from claim 18 and further limits the claimed network element. Because Leaf does not have all of the elements of claim 18, it cannot anticipate the unique combination claimed in claim 19. The rejection of claim 19 is respectfully traversed.

Claim 20 depends from claim 19 and further limits the claimed generating means element. Because Leaf does not have all of the elements of claim 19, it cannot anticipate the unique combination claimed in claim 20. The rejection of claim 20 is respectfully traversed.

Claim 15 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Leaf in view of U.S. Patent No. 6,725,426, issued

to Pavlov (hereinafter referred to as "Pavlov"). This ground of rejection is respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness as specified by MPEP 2143.

To make a *prima facie* case of obviousness, the Examiner has the burden to present evidence and argument with regard to the following three factors: 1) motivation to make the alleged combination; 2) reasonable likelihood of success of the alleged combination; and 3) all elements of the claimed invention within the alleged combination. The Examiner has not made these three showings.

In attempting to show motivation for the combination of Pavlov with Leaf, the Examiner states:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Leaf and Pavlov because one of ordinary skill would have recognized the advantages that XML has over HTML as taught within Pavlov and been motivated to combine the teachings of the references in order to utilize the more advantageous XML format.

In other words, because XML format exists, it is obvious to combine Pavlov with Leaf for the purposes of finding claim 15 unpatentable. This is precisely the unsupported conclusion attacked by the Court of Appeals for the Federal Circuit stating in part:

Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence".
In re Dembiczaak, 175 F.3d 994, 50 U.S.P.Q. 2d 1614 (Fed. Cir. 1999).

Therefore, the alleged combination of Pavlov with Leaf is not motivated as a matter of law.

The Examiner does not even mention his obligation to show "reasonable likelihood of success".

Finally, the alleged combination does not have the claimed elements even if it were motivated and likely to succeed. Claim 15 requires "Composing a service request in a XML". The cited portions of Leaf do not compose a service request at all, and Pavlov is dedicated to a "Mechanism for Translating between Word Processing Documents and XML Documents". Nowhere is there even a suggestion to compose a "service request" in XML.

The rejection of claim 15 is respectfully traversed for failure of the Examiner to make any of the three showings of a *prima facie* case of obviousness as required by MPEP 2143.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-20, as amended, being the only pending claims.

Please charge any deficiencies or credit any overpayment to Deposit Account No. 14-0620.

Respectfully submitted,
Daniel P. Starkovich et al.

By their attorney,



Wayne A. Sivertson

Reg. No. 25,645

Suite 401

Broadway Place East
3433 Broadway Street N.E.
Minneapolis, Minnesota
55413
(612) 331-1464

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